

### REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and in light of the following discussion is respectfully requested.

Claims 18-22, 24-29 and 35-42 are pending. The present response amends Claims 18, 24-26 and 35, and newly submits Claims 36-42. No new matter is introduced.<sup>1</sup>

In the Office Action dated July 17, 2007, Claim 22 was rejected under 35 U.S.C. § 112, second paragraph; Claims 18, 20-22, 26-28 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Dauba (WO 00/02825);<sup>2</sup> and Claims 19, 24, 25 and 29 were rejected under 35 U.S.C. § 103(a) as obvious over Dauba.

Claim 22 was amended in an Amendment that was timely filed on October 17, 2007. An Advisory Action mailed October 26, 2007 indicated that the Amendment filed on October 17, 2007 would be entered and overcomes the rejection under 35 U.S.C. § 112, second paragraph. Accordingly, Applicants request the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

Applicants acknowledge with appreciation the courtesy of Examiner Parker in conducting a personal interview with Applicants' representative on May 27, 2009. During the personal interview, Applicants' representative presented potential amendments to the claims. Examiner Parker and Applicants' representative also discussed clarifying applying

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<sup>1</sup> Support for the amended claims can be found at least at page 4, lines 19-31, and at page 5, line 38 to page 6, line 5 of the specification as originally filed. Support for new Claims 36-42 can be found at least at page 4, line 8 to page 8, line 33 of the specification as originally filed.

<sup>2</sup> The Office Action dated January 8, 2007 identifies U.S. Patent No. 6,430,964 as equivalent to WO 00/02825. For the sake of consistency and clarity, all further references to Dauba in the present response will be directed to U.S. Patent No. 6,430,964.

the marking layer to the marking field and the effects discussed on pages 4, 6 and 8 of the specification as originally filed. Examiner Parker indicated that these amendments would appear to overcome the rejection based on Dauba.

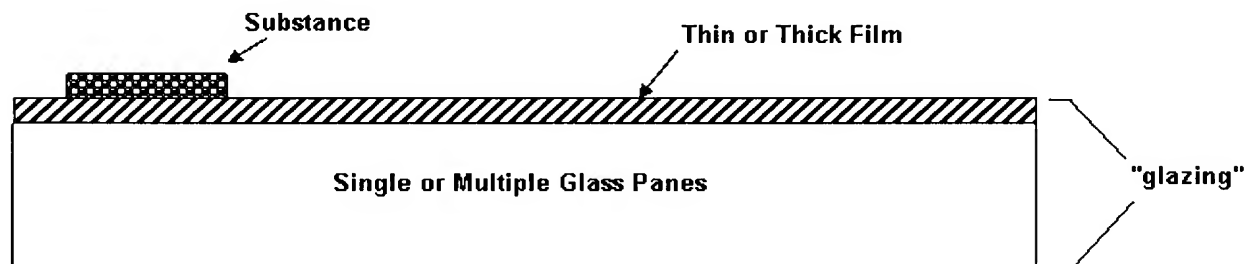
Claim 18 recites a method for visual marking glass panes that are tempered and then heat-treated. Amended Claim 18 recites the method includes producing a marking field that includes an uneven surface structure *on a limited area* of a smooth side surface of a glass pane. The limited area *is smaller than* a total area of the side surface of the glass pane. A marking layer is permanently bonded to the marking field, and the color of the marking layer is irreversibly modified by a heat treatment.

Following from the discussion during the personal interview, Claim 18 further recites depositing a marking layer on the marking field such that the marking layer penetrates intermediate spaces or hollows within the marking field so as to create an intimate adhesive bond between the marking layer and the marking field.

As discussed during the personal interview, Applicants have recognized the benefits of improved adhesion that result from applying the marking layer to the claimed marking field rather than directly to an untreated surface of a glass pane or an untreated film that covers the glass pane. For example, page 4, lines 28-31 of the specification as originally filed describes that the marking field forms a very good base for depositing the marking layer, with the result that the latter can be removed only at great cost and almost always still leaving traces thereof. In another example, page 6, lines 11-26 of the specification as originally filed describes that because of the intimate bonding between the marking layer and the structured surface of the subjacent marking field, if an unauthorized attempt was made to remove the

marking in addition to the marking field, this would in all cases leave clear traces on the surface of the substrate, which would make one suspect that the substrate in question had been manipulated.

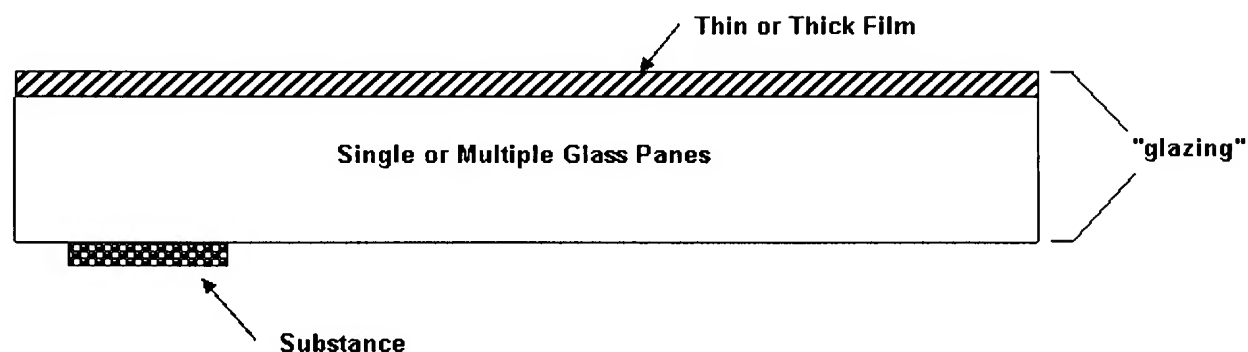
Turning to the applied reference, Dauba relates to a method of identifying glazing that has undergone a heat treatment. Initially, Applicants note that Dauba states “[t]he term ‘glazing’ encompasses single or multiple glass panes, these being bare or coated with thin films, such as pyrolytic films, or with thick films, such as enamels.”<sup>3</sup> With respect to identifying whether a particular glazing has undergone a heat treatment, Dauba describes “fixing a substance [t]o its surface and/or onto an edge, an optical characteristic of the [ ] substance being modified at a temperature reached during the heat treatment. In the case of glazing that includes thin or thick films, the substance may be fixed either on the glass or on [t]he film.”<sup>4</sup> In effect, Dauba describes that, in the case of glazing that includes thin or thick films, a substance is applied to the glazing in one of the two following ways:



OR

<sup>3</sup> See Dauba, at col. 1, lines 5-8.

<sup>4</sup> See Dauba, at col. 2, lines 52-59.



However, as is readily apparent from the above illustrations, Dauba fails to disclose or suggest producing a marking field *on a limited area* of a smooth side surface of a glass pane in which the limited area *is smaller than* a total area of the side surface of the glass pane. Indeed, even if the thin or thick films of the glazing described in Dauba are identified as the claimed marking field, Dauba states that the glass panes are “coated with” these films. One of ordinary skill in the art would recognize that a pyrolytic film or enamel that coats a surface of a glass pane is not restricted to *a limited area* of a smooth side surface of a glass pane in which the limited area *is smaller than* a total area of the side surface of the glass pane, as required by the marking field recited in amended Claim 18.

Accordingly, Dauba fails to disclose or suggest all of the features of Claim 18. It is submitted Claim 18 and the claims depending therefrom are in condition for allowance.

Amended independent Claim 35 recites producing a marking field *on a local portion* of a surface of a side of a glass pane by a *local modification*. The local portion of the surface of the side of the glass pane is *a limited surface area* on the side of the glass pane that is *smaller than* a total surface area of the side of the glass pane. Claim 35 further recites depositing a marking color on said marking field so as to produce a marking layer.

As noted above, Dauba describes fixing a substance either directly to a glass pane or to a thin or thick film that coats the glass pane. Thus, Dauba fails to disclose or suggest the claimed marking field that is produced on *a local portion of* a surface of a side of a glass pane that is *a limited surface area* on the side of the glass pane that is *smaller than* a total surface area of the side of the glass pane.

Accordingly, Dauba fails to disclose or suggest all of the features of Claim 35. It is submitted Claim 35 and the claims depending therefrom are in condition for allowance.

New Claim 36 recites a method for visually marking glass panes that includes *locally modifying* a surface of a first face of a glass pane so as to produce a marking field that includes an uneven surface that is *more rough than* portions of the surface of said first face that are not within the marking field. The method further includes depositing a layer of thermochromic marking color on the marking field.

Dauba fails to disclose the *local modification* recited in Claim 36. Instead, Dauba describes fixing a substance either directly to a glass pane or to a thin or thick film that coats the glass pane. Neither of these activities encompasses the *local* modification recited in Claim 36 that is then followed by depositing a layer of thermochromic marking color on the marking field created by the *local* modification recited in Claim 36.

Accordingly, Dauba fails to disclose or suggest all of the features of Claim 36. It is submitted Claim 36 and the claims depending therefrom are in condition for allowance.

For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal

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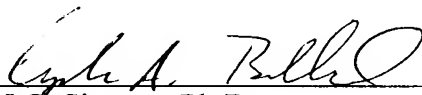
Reply to Decision by the Board of Patent Appeals and Interferences dated April 8, 2009, the Advisory Action dated October 26, 2007 and the Office Action dated July 17, 2007.

allowance. Therefore, a Notice of Allowance for Claims 18-22, 24-29 and 35-42 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

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